



UNITED STATES PATENT AND TRADEMARK OFFICE

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COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, D.C. 20231  
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In re

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:  
: DECISION ON  
: PETITION FOR REGRADE  
: UNDER 37 CFR 10.7(c)  
:

**MEMORANDUM AND ORDER**

(petitioner) petitions for regrading his answers to questions 8, 11, 12, 15 and 32 of the morning section of the Registration Examination held on April 17, 2002. The petition is denied to the extent petitioner seeks a passing grade on the Registration Examination.

**BACKGROUND**

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 67. On July 19, 2002, petitioner requested regrading, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, a single final agency decision will be made regarding each request for regrade. The decision will be reviewable under

35 U.S.C. § 32. The Director of the USPTO, pursuant to 35 U.S.C. § 2(b)(2)(D) and 37 CFR 10.2 and 10.7, has delegated the authority to decide requests for regrade to the Director of Patent Legal Administration.

### **OPINION**

Under 37 CFR 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The directions state: " No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the morning and afternoon sections state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the USPTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a court decision, a notice in the Official Gazette, or a notice in the Federal Register. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct answer is the answer that refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the

statement true. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms “USPTO” or “Office” are used in this examination, they mean the United States Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers. All of petitioner's arguments have been fully considered. Each question in the Examination is worth one point.

Petitioner has been awarded an additional 2 points for morning questions 11 and 12 . Accordingly, petitioner has been granted an additional 2 points on the Examination. No credit has been awarded for morning questions 8, 15 and 32. Petitioner's arguments for these questions are addressed individually below.

Morning question 8 reads as follows:

8. On March 20, 2000, Patsy Practitioner filed a patent application on widget Y for the ABC Company based on a patent application filed in Germany for which benefit of priority was claimed. The sole inventor of widget Y is Clark. On September 13, 2000, Patsy received a first Office action on the merits rejecting all the claims of widget Y under 35 U.S.C. § 103(a) as being obvious over Jones in view of Smith. When reviewing the Jones reference, Patsy notices that the assignee is the ABC Company, that the Jones patent application was filed on April 3, 1999, and that the Jones patent was granted on January 24, 2000. Jones does not claim the same patentable invention as Clark's patent application on widget Y. Patsy wants to overcome the rejection without amending the claims. Which of the following replies independently of the other replies would not be in accordance with proper USPTO practice and procedures?

(A) A reply traversing the rejection by correctly arguing that Jones in view of Smith fails to teach widget Y as claimed, and specifically and correctly pointing out claimed elements that the combination lacks.

(B) A reply traversing the rejection by relying on an affidavit or declaration under 37 CFR 1.131 that antedates the Jones reference.

(C) A reply traversing the rejection by relying on an affidavit or declaration under 37 CFR 1.132 containing evidence of criticality or unexpected results.

(D) A reply traversing the rejection by stating that the invention of widget Y and the Jones patent were commonly owned by ABC Company at the time of the invention of widget Y, and therefore, Jones is disqualified as a reference via 35 U.S.C. § 103(c).

(E) A reply traversing the rejection by perfecting a claim of priority to Clark's German application, filed March 21, 1999, disclosing widget Y under 35 U.S.C. § 119(a)-(d).

8. The model answer: The correct answer is (D). The prior art exception in 35 U.S.C. § 103(c) only applies to references that are only prior art under 35 U.S.C. § 102(e), (f), or (g). In this situation, the Jones patent qualifies as prior art under § 102(a) because it was issued prior to the filing of the Clark application. See MPEP § 706.02(l)(3). Answer (A) is a proper reply in that it addresses the examiner's rejection by specifically pointing out why the examiner failed to make a prima facie showing of obviousness. See 37 C.F.R. § 1.111. Answer (B) is a proper reply. See MPEP § 715. Answer (C) is a proper reply. See MPEP § 716. Answer (E) is a proper reply because perfecting a claim of priority to an earlier filed German application disqualifies the Jones reference as prior art.

Petitioner argues that answer (C) is correct as he believes it was the least proper reply. Petitioner contends that the question asks: "Which of the following replies independently of the other replies would not be in accordance with USPTO practice and procedures?" In other words, *which of the following replies alone would not place the application in*

*condition for allowance?* Petitioner argues that answer (C) does not necessarily place the application in condition for allowance, because the “reply traversing the rejection by relying on an affidavit or declaration under 37 CFR 1.132 containing evidence of criticality or unexpected results,” as (C) states, is redundant and would not place the application in condition for allowance.

Petitioner’s arguments have been fully considered but are not persuasive. Contrary to petitioner’s statement that the “reply traversing the rejection by relying on an affidavit or declaration under 37 CFR 1.132 containing evidence of criticality or unexpected results,” as (C) states, is redundant and would not place the application in condition for allowance, a reply traversing the rejection by relying on an affidavit or declaration under 37 CFR 1.132 containing evidence of criticality or unexpected results may be used to overcome a *prima facie* case of obvious, if upon reconsideration of the entire record, such rebuttal evidence of nonobviousness is found to outweigh the evidence of obviousness. See MPEP § 716. Accordingly, model answer (D) is correct and petitioner’s answer (C) is incorrect.

No error in grading has been shown. Petitioner’s request for credit on this question is denied.

Morning question 15 reads as follows:

15. Able is a registered solo practitioner. Ben asks Able to prepare and prosecute an application for a utility patent. As part of the application, Able prepares a declaration and power of attorney, which Ben reviews and signs. Able files the application, the declaration, and power of attorney with the USPTO. Able quickly recognizes that help is necessary and contacts another registered practitioner, Chris, who often assists Able in such instances. Able, with Ben’s consent, sends a proper associate power of attorney to the Office for Ben’s application and directs that correspondence be sent to Chris. The examiner in the application takes up the application in the regular course of examination and sends out a rejection in an Office action. Chris sends a copy of the action to Ben to obtain Ben’s comments on a proposed response. Unfortunately, after the first Office action, Able becomes terminally ill and dies. Ben does not know what to do, so Ben calls the examiner at the number on the Office action and explains that A died and Ben is worried how to proceed. Which of the following statement(s) is/are true?

(A) Chris should inform Ben that the Office will not correspond with both the registered representative and the applicant and therefore, Ben should not have any further contact with the Office and let Chris send in a proper response.

(B) Ben should send in a new power of attorney for anyone Ben intends to represent him before the Office.

(C) Ben should execute and sent to the USPTO a new power of attorney for any registered patent practitioner that Ben intends to have represent him before the Office.

(D) (B) and (C).

(E) None of the above.

15. The model answer: (C). MPEP § 406. Answer (C) is a true statement because the Ben may appoint a registered practitioner to represent him. Answer (A) is incorrect because the power of a principal attorney will be revoked or terminated by his or her death. Such a revocation or termination of the power of the principal attorney will also terminate the power of those appointed by the principal attorney. Therefore, Chris's associate power of attorney is revoked and Chris cannot continue representing Ben without a new power of attorney from Ben. Furthermore, the Office will send correspondence to both Chris and Ben in the event of notification of Able's death. (B) is not the best answer because it suggests Ben may appoint a non-practitioner to prosecute the application and because it does not require the power of attorney to be executed (*cf.* answer (C)). (D) is not the best answer because it includes (B). (E) is false because (C) is true.

Petitioner argues that answer (D) is correct. Petitioner contends that both (B) and (C) are correct answers. Petitioner asserts that the model answer states that (B) is incorrect because it suggests Ben may appoint an unregistered practitioner and because it does not state "execute." The most important part of this question is as follows: "Which of the following statement(s) is/are true?" Note that it does not state which is the best and most complete answer. Petitioner contends that it is incorrect to assume that Ben is going to appoint an unregistered practitioner, especially when he appointed a registered practitioner the first time. Petitioner also contends that while (B) does not refer to "execute", that he correctly assumed that the new power of attorney would be executed, as it is reasonable to assume that Ben will execute the power of attorney if he prepares it.

However, as explained in the directions for taking the test, and repeated above, the most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the USPTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a court decision, a notice in the Official Gazette, or a notice in the Federal Register. There is only one most correct answer for each question.

Petitioner's arguments have been fully considered but are not persuasive. The burden is on petitioner to show that their chosen answers are the most correct answers.

Petitioner's assumption that the person Ben selected in his power of attorney would be a registered practitioner, since the first attorney was registered, is inappropriate, as neither selection (B) nor the fact pattern specifically identifies whom Ben intends. Instead, selection (B) indicates that Ben may send in a power of attorney for anyone, as distinguished from selection (C) that indicates that Ben may send in a power of attorney for only a registered practitioner. Similarly, the assumption that the power of attorney

would be executed is inappropriate as well. The directions for the examination state, "Do not assume any additional facts not presented in the questions." Petitioner's argument is based on additional facts not given in answer (B). Since "anyone" could include someone that is a non-registered practitioner, and is not limited to a registered practitioner, petitioner cannot make the assumption that Ben would appoint a registered practitioner. Ben may not appoint a non-practitioner, as suggested by selection (B). Accordingly, answer (B) is not the best answer because it suggests Ben may appoint a non-practitioner to prosecute the application and because it does not require the power of attorney to be executed. Since (B) is not the most correct answer, therefore answer (D) is incorrect. Accordingly, model answer (C) is correct and petitioner's answer (D) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 32 reads as follows:

32. Johnnie owns a supermarket store in Cleveland, Ohio, and is constantly frustrated when little children drop their chewing gum on Johnnie's clean floor in the supermarket. In her spare time, Johnnie develops an entirely novel type of coating material that she applies to floor tile. The coating material resists adhesion to chewing gum. In order to check out the effectiveness of the floor tile coating material, on December 31, 2000, she secretly covers the floor tiles in her supermarket with the new chewing gum resistant floor tile coating material. Johnnie is amazed at the results inasmuch as cleaning the floor was never easier. On January 30, 2001, Johnnie, satisfied with the experimental use results, ceased testing the use of the coating material. The ability of the coating material to withstand chewing gum adhesion continued unabated throughout the remainder of 2001. On January 1, 2002, one of Johnnie's many customers, James, remarked at how clean the floor looked. Johnnie then told James of her invention. James thinks for one moment and suggests that the floor tile coating material may be useful in microwave ovens, so that food will not stick to the interior sides of the microwave oven. James discusses getting patent protection with Johnnie. Which of the following is true?

(A) Johnnie could never be entitled to a patent on a floor tile in combination with a coating material affixed to the outer surface of the tile.

(B) James can be named as a co-inventor with Johnnie in a patent application claiming a microwave oven wherein the internal surfaces of the oven are coated with the coating material.

(C) Since for one year Johnnie told nobody that the floor tile in her supermarket contained the new chewing gum resistant coating material, she would never be barred from obtaining patent protection for the floor coating material.

(D) Use of the floor tile coating material in microwave ovens would have been obvious to one of ordinary skill in the art, since James thought of it within seconds after first learning of the floor tile coating material, and James was not skilled in the art.

(E) The floor tile having the coating material affixed to the outer surface of the tile, an article of manufacture, would not be patentable as of January 1, 2002 inasmuch as the article was in public use on the supermarket floor for one year.

32. The model answer: (B). Since Johnnie developed the material and James thought of the idea to use it in microwave ovens, they rightfully could be considered co-inventors of the new article of manufacture. As to (A) and (C), public use began on when the experimental use ended on January 30, 2001, and occurs even when the public is unaware that they were walking on the developed material since the material was used in a public place. As to (D), even though James only took a second to think of the idea, he is entitled to receive a patent unless it was obvious to one of ordinary skill in the art. Nothing in the prior art revealed that it was obvious to use the material in microwave ovens. As to (E), the article of manufacture is not barred even though the floor material itself cannot be patented. Johnnie conducted an experimental use of the article from December 31, 2000 through January 30, 2001. Thereafter, Johnnie had one year from the end date of the experimental use to file a patent application for the article. Johnnie may file a patent application before January 30, 2002.

Petitioner argues that answer (E) is correct, and that Johnnie knew the experiment worked on December 31, 2000, and accordingly, the article of manufacture was in public use beginning on that day. Petitioner also contends that in examining the facts of the question demonstrates that there was no experimental use beyond December 31, 2000, as beyond that date Johnnie did not collect any additional data, nor did she make any modifications or refinements to her invention. Petitioner notes that Johnnie did not remove her invention and keep it from public use after she allegedly completed her testing, but was satisfied with how it worked and forgot about it until she told James of her invention more than one year later.

Petitioner's arguments have been fully considered but are not persuasive. Petitioner contends that answer (E) is correct, and that Johnnie knew the experiment worked on December 31, 2000, and accordingly, the article of manufacture was in public use beginning on that day. Petitioner also contends that in examining the facts of the questions demonstrates that there was no experimental use beyond December 31, 2000. This is not persuasive, as it appears that petitioner is jumping to a conclusion that is not part of the fact pattern. It should be noted that the directions for the examination state, "Do not assume any additional facts not presented in the questions." Petitioner's argument is based on assumption, specifically, "that there was no experimental use beyond December 31, 2000." However, the question specifically sets forth that "On January 30, 2001, Johnnie, satisfied with the experimental use results, ceased testing the use of the coating material." Therefore, the fact pattern clearly identifies that the experimental use concluded on January 30, 2001, and not, as petitioner proposes, on



December 31, 2000. Therefore, with regard to answer (E), since Johnnie conducted an experimental use of the article from December 31, 2000 through January 30, 2001, Johnnie had one year from the end date of the experimental use to file a patent application for the article. Therefore, Johnnie may file a patent application before January 30, 2002. The article of manufacture is not barred even though the floor material itself cannot be patented. Accordingly, model answer (B) is correct and petitioner's answer (E) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

**ORDER**

For the reasons given above, 2 points have been added to petitioner's score on the Examination. Therefore, petitioner's score is 69. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.

A handwritten signature in black ink, appearing to read 'Robert J. Spar', is positioned above the printed name and title.

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Robert J. Spar  
Director, Office of Patent Legal Administration  
Office of the Deputy Commissioner  
for Patent Examination Policy